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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/606,469	06/25/2003	Philip M. Sadler	55138-CON(71331)	3506
21874	7590	03/21/2006	EXAMINER	
EDWARDS & ANGELL, LLP			NGUYEN, THONG Q	
P.O. BOX 55874			ART UNIT	
BOSTON, MA 02205			PAPER NUMBER	
			2872	

DATE MAILED: 03/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/606,469

Applicant(s)

SADLER, PHILIP M.

Examiner

Thong Q. Nguyen

Art Unit

2872

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 January 2006 and 20 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-16 and 21-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 21-23 is/are allowed.
- 6) ☒ Claim(s) 1,2,4-16,24 and 25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on Jan. 18, 2006 has been entered.

Response to Amendment

2. The present Office action is made in response to the amendments filed on 12/20/05 and 2/2/06. It is noted that in the amendment of 12/20/05, applicant has amended claims 1, 21 and 24-25, and in the amendment of 2/2/06, applicant has resubmitted a list of pending claims in which applicant has corrected the status indicator of claim 23 in response to the Notice of non-compliant amendment of 1/26/06.

3. The pending claims 1-2, 4-16 and 21-25 are examined in this Office action. Note that claims 3 and 17-20 were canceled by applicant in the amendments of 5/5/05 and 6/25/03, respectively.

Specification

4. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The specification does not provide a proper antecedent basis for 1) the feature that the image of the sun is visible from "an opposite face of

screen from the objective lens, the at least two light folding devices, and the second lens” as recited in claim 1 (lines 9-11) or 2) the feature that the image of the sun is visible from “an opposite face of screen from two or more light folding device” as recited in claim 21 (lines 10-11) or the feature thereof “the image of the sun is projected on an interior surface of the telescope frame... an opposite face from the at least two light folding device and the second lens” as recited in claim 24 (lines 10-12). Applicant is respectfully invited to review the specification, in particular, page 5 (the second paragraph) and page 18 (the third paragraph) which do not use the language as claimed.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-2, 4-16 and 24-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a) Claim 1 is rejected under 35 USC 112, second paragraph for the following reasons.

First, it is unclear about the structural relationship between the projection surface recited on line 4 of the claim and the translucent screen for displaying the image of the sun projected onto it as recited on lines 9-10 of the claim. Applicant should note that the specification does not disclose both a projection surface and a

screen for displaying the image of the sun. Should --on said projection surface-- be added after "arranged" (line 9) to make clear the feature claimed?

Second, the claim recites both a broad range/limitation and a narrow range/limitation related to the manner in which the image of the sun is viewed.

Applicant should note that a broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, the claim recites the broad recitation thereof "the image is observable from the exterior of the telescope frame" (lines 11-12), and the claim also recites the feature thereof "an image of the sun...the second lens" (lines 9-11) which is the narrower statement of the range/limitation. Applicant should note that a position located in

the exterior of the telescope frame is not necessary is a position in the opposite face of the screen.

b) Claim 5 is indefinite because the feature thereof "the telescope elevation" (lines 2-3) lacks a proper antecedent basis. Applicant should note that claim 4 (line 3) discloses/provided the feature related to the feature mentioned in claim 5, not claim 1. Should claim 5 be amended to depend upon claim 4 to avoid the problem of 35 USC 112, second paragraph?

c) Claim 7 is indefinite because it is unclear about the structure of the polygon as recited in the feature thereof "a regular polygon" (line 2). In other words, it is unclear about the number of sides and their structural arrangement from the so-called "regular polygon".

d) Claim 24 is rejected under 35 USC 112, second paragraph because it is unclear about the structural relationship between the projection surface recited on line 4 of the claim and the interior surface of the telescope frame for displaying the image of the sun projected onto it as recited on lines 10-11 of the claim. Applicant should note that the specification does not disclose both a projection surface and an exterior surface of the telescope frame display the image of the sun. Should --on said projection surface located -- be added after "projected" (line 10) to make clear the feature claimed?

e) Claim 25 is indefinite because it is unclear about the structure of the polygon as recited in the feature thereof "a regular polygon" (line 2). In other words, it is

unclear about the number of sizes and their structural arrangement from the so-called "regular polygon".

f) The remaining claims are dependent upon the rejected base claim and thus inherit the deficiencies thereof.

Claim Rejections - 35 USC § 103

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

8. Claim 25, as best as understood, is rejected under 35 U.S.C. 103(a) as being unpatentable over James (U.S. Patent No. 3,603,664, of record) in view of Braymer (U.S. Patent No. 2,753,760, of record) and Carlisle (U.S. Patent No. 5,416,632).

James discloses a telescope system having a telescope rotatably mounted on a mounting system. The telescope system as described in columns 3-4 and shown in figures 1-2 comprises the following features: First, a telescope assembly having optics including at least two light folding elements (24, 25, 26), an eyepiece or camera (28) disposed near the focus (F) of the system, and a projecting surface located around the position of the eyepiece or camera; Second, a telescope frame (20) for supporting the optics of the telescope assembly; and Third, a mounting system (12) having a curved supporting surface for rotatably supporting the telescope frame wherein the center of curvature of the curved surface © does not change during the process of rotation the telescope frame. It is noted that the mounting system (12) has a diameter which is matched or larger than the diameter of the telescope frame (14). It is also

noted that each of the light folding elements is in the form of a mirror, and the range of the rotating angle cover a range of 0 degree to 90 degrees. The use of bearing elements (30) and ring (40) will stabilize the telescope frame at any specified elevation.

The features missing from the telescope system provided by James is that he does not explicitly state the use of an objective lens in the telescope assembly, and the shape of the telescope frame is a regular polygon as claimed. However, a telescope system having a lens located in the object side of the telescope which also comprises a pointing system is known to one skilled in the art as can be seen in the telescope system provided by Braymer. In his telescope system described in columns 2-3 and shown in figures 1-2, Braymer discloses the use of a lens element (7) at the object side of the telescope system and a pointing system having objective lens (19') which is in combination with a prism (18) provides a visual guide having an optical axis parallel to the axis of the light incident onto the first mirror (5,6). Thus, it would have been obvious to one skilled in the art at the time the invention was made to modify the telescope system having a telescope frame supporting optics and a mounting system as provided by James by using a telescope assembly having a lens in the object side as suggested by Braymer for the purpose of correcting the image aberrations.

While the combined product as provided by James and Braymer does not disclose that the shape of the telescope frame has a regular polygon; however, it

was decided in the Courts that a change in shape of an element is within the level of one skilled in the art. See *In re Dailey*, 149 USPQ 47 (CCPA 1976). It is also noted that the use of a telescope having a telescope frame supporting a telescope assembly having mirrors wherein the shape of the telescope frame has a rectangular configuration is known to one skilled in the art as can be seen in the telescope provided by Carlisle. In particular, in columns 3-5 and figs. 3 and 7, Carlisle discloses a telescope system having a telescope frame (21) of a rectangular configuration which is a form of the so-called "regular polygon". Thus, it would have been obvious to one skilled in the art at the time the invention was made to modify the combined product provided by James and Braymer by using a rectangular frame as suggested by Carlisle for supporting the telescope assembly to increase the stability of the system.

Allowable Subject Matter

9. Claims 21-23 are allowed.
10. Claims 1-2, 4-16 and 24 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

Response to Arguments

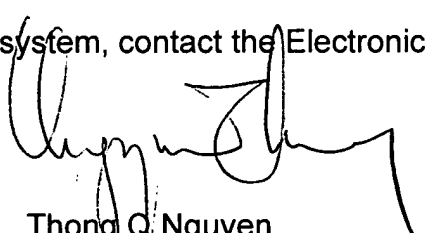
11. Applicant's arguments with respect to amended claim 25 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thong Q Nguyen whose telephone number is (571) 272-2316. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew A Dunn can be reached on (571) 272-2312. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Thong Q. Nguyen
Primary Examiner
Art Unit 2872
